

REMARKS

Claims 22 – 37, 55 and 59 - 80 are pending. Applicant incorporates by reference the August 3, 2007 Amendment and Response as well as the December 12 Request.

As an initial matter, Applicant requests the removal of the “final” status for this case. The Office Action states that there are “new” grounds of rejection, necessitated by applicant’s “amendment.” The Applicant cannot discern any “new” grounds of rejection; moreover, there was no amendment made to any of the original claims. Consequently Applicant submits that the designation of Final is premature.

In any event, the rejection of the claims is addressed by traverse, given the declaration submitted in the prior response from one of the inventors swearing behind the main cited reference: O’Kane – US Publication No. 2003/0097299. Accordingly it is believed that such rejections are moot for the reasons already expressed in the August 3, 2007 Amendment A and Response. The rejections under §112 are also addressed again. No new matter is introduced in this amendment.

In summary:

- 1) Claims 1-23, 31- 35 have been withdrawn; thus, any and all references by the Examiner to these claims (see e.g. paragraph 3.C) are not addressed herein;
- 2) the §112 rejections were addressed already by the Applicant in the August 3, 2007 response, without comment or rebuttal to date by the Examiner;
- 3) the Examiner acknowledges new claims 59 – 80 in paragraph 1. However no rejections were made by the Examiner for claims 59 – 80. Absent a documented rejection these claims should be deemed allowable;
- 4) the Examiner’s continued citation of O’Kane is no longer supportable given the provided declaration swearing behind such reference.
- 5) the finality should be withdrawn.

Paragraph 4-5: Rejection of claims 22, 24, 25, 27, 35 and 37

The Examiner again suggests that the phrase “and/or” in the above claims renders them indefinite, apparently relying on §112(2). This rejection is traversed – again - based on the following, which was provided in the August 3, 2007 Amendment A, but which the Examiner did not address in the December 7, 2007 response.

First, the recitation in claim 22 is as follows:

....(c) a first software routine executing on said first computer **and/or** said second computer, said first software routine being adapted to coordinate transfer of said digital asset to said second computer;

Applicant submits that this language is perfectly clear to one skilled in the art, particularly when taken in light of the specification. The limitation merely states that the first software routine could be executing on either or both of the first and second computers. This routine is responsible for coordinating the transfer of the digital asset to the second computer, and could include different components.

As such, it would be apparent to one skilled in the art from such language that the routine does not need to reside in any particular physical location, a fact that the claim language expresses quite accurately and is supported in the specification. See e.g., page 21, ll. 5 – 11; “...For ease of use, the setup and transfer may be performed by either or both of such devices...” Consequently the Applicant respectfully submits that the claim as written is certainly definite.

For claim 24 the analysis is essentially the same.

For claim 25, the language states that “...at least said second computer is a portable electronics device, including a personal computer, a personal digital assistant, and/or a telephone.” As the Examiner is probably aware, many telephones today (particularly cellphones) include computers and computing capabilities. So the phrasing of the claim is believed to be appropriate and commensurate with the notion that these devices could be separate or integrated together, and such concept would be understood by one skilled in the art from reading the claim and disclosure.

For claim 27 the language states:

wherein said second unique identifier is based on combining information from any one or more of the following: a first id for said first computer, a second id for said second computer, an asset id for said digital asset, a customer id, a randomly generated number and/or a time of said transfer.

Again the fact that all or some of these parameters may be considered in generating the second identifier is well explained in the specification: see e.g., page 18, l. 20 – page 19, l. 10; page 25, ll. 25+.

With respect to claims 35 and 37 again the specification is clear enough to explain that the content could be any or all of the forms expressed in claim 35; and that the second computer could be integrated in any or all of the environments listed (claim 37). Accordingly reconsideration is requested of these rejections as well.

Paragraphs 6 – 7 - Rejection of claims 22 - 37 and 55 in light of O’Kane

These claims were rejected under a single § 102(e) count, based on the O’Kane reference, US Publication No. 2003/0097299. This reference has an effective filing date of November 21, 2001 (“prior art date”).

To overcome this reference the Applicant previously submitted the declaration of one of the inventors, Mr. Bryan Dunkeld, to explain that the invention of these claims was conceived before such prior art date, and diligently reduced to practice (on December 10, 2001) beginning from at least a time immediately before such prior art date. Supporting/corroborating materials are also provided in Mr. Dunkeld’s declaration to satisfy the requirements of 37 C.F.R. 1.132.

Since no other substantive rejections are presented in the present record, Applicant submits that the claims should be passed on for allowance.

New claims 59 – 80

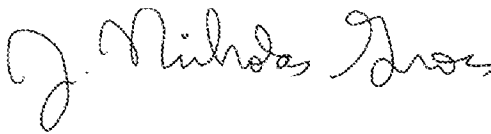
The Final Office Action of December 7, 2007 makes no mention of a rejection for these claims. Given the lack of rejection the Applicant submits that they should be passed on for allowance. Support for these claims was provided in the August 3, 2007 filing.

Conclusion

The rejections and objections from the Examiner have been addressed in detail as noted above. For the reasons set forth above, the undersigned submits that the claims should be confirmed as patentable over the references.

Should the Examiner wish to discuss the present case at any time, please contact the undersigned at any convenient opportunity.

Respectfully submitted,

A handwritten signature in cursive script, reading "J. Nicholas Gross".

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